

## **REMARKS**

### **1. Status of the Claims**

Claims 1-32 stand pending. Claims 1-32 are subject to the Restriction/Election Requirement.

Applicants have amended claim 7 to depend from claim 2. No prohibited new matter is introduced by entry of this amendment.

### **2. Information Disclosure Statements**

Applicants respectfully request acknowledgment of the Information Disclosure Statement provided September 15, 2006.

### **3. Status of the Drawings**

Applicants respectfully request status of acceptance of the formal figures.

### **4. Species Election Requirement**

The Office alleges that the present claims are directed to more than one species of the generic invention. Office Action at page 2. Specifically, the Office alleges that these species are not so linked as to form a single general invention concept under PCT Rule 13.1, and thus lack unity of invention. The Office requires the species election from the following:

- 1) Tween, CHAPS, N-octyl-beta-D-glucoside, triton X-100, and Nonidet p40;
- 2) Superose-12 column, Superdex-200 column, Sephacryl column, and sephadex column;
- 3) NaCl, LiCl, and KCl;
- 4) HEK293T cell and HEK 293 EPNA cell; and
- 5) c-myc tag and His<sub>6</sub>-tag.

The Office apparently requires the Applicants to *elect a single species from each above-listed groups*. These species all look to be provisional and for search purposes only.

**5. Election with Traverse**

Applicants elect each of the following species *with traverse*.

**Species 1.** Applicants elect Tween for the detergent *with traverse*. Claims 1-32 are believed to encompass the elected species.

**Species 2.** Applicants elect Superdex-200 for the column *with traverse*. Claims 1-32 are believed to encompass the elected species.

**Species 3.** Applicants elect NaCl for the salt *with traverse*. Claims 1-32 are believed to encompass the elected species.

**Species 4.** Applicants elect HEK293T cells for the cell line *with traverse*. Claims 1-32 are believed to encompass the elected species.

**Species 5.** Applicants elect the His<sub>6</sub> Tag tag. Claims 1-31 are believed to encompass the elected species.

Applicants respectfully traverse the species election requirement. Applicants submit that the species election is unreasonable and unsupported for the following reasons:

**5.1 The Office fails to establish serious burden in order to search all the species and has failed to support that each species is independent or distinct**

Restriction is proper only if the inventions are independent or distinct as claimed *and* there would be a serious burden on the Office if restriction were not required. *See* M.P.E.P. §§ 803, 808; *see also* M.P.E.P. § 808.02 (establishing burden). The Office has evinced no burden to search the indicated species. The Office also failed to demonstrate how the species were independent or distinct.

Additionally, the Office cannot properly support its position of burden, when the ISA *already has searched* all the claimed subject matter. Applicants note that the International Preliminary Report on Patentability *does not indicate a lack of unity of invention*. When unity is found in the PCT application, there is an *increased* burden above the already “serious burden” in evincing why a restriction requirement is necessary. *See* Anthony Caputa, “Two Be or Not to Be” or Divide and Conquer” or A Case Divided Cannot Stand: Principles in Restriction Practice

TC 1600,” presented August 2004 to the Customer Partnership Meeting. As stated by Examiner Caputa, “If the inventions, now being restricted, were searched and examined together in either the current application or a parent, it will be difficult to justify the assertion of burden.” Burden went whole unaddressed by the office, and thus the species election is improper.

Applicants further note that the Office has failed to show that unity is even destroyed. Accordingly, the Office must search *all* the species. At most, this species election can be used for *search purposes only*.

Additionally, M.P.E.P. § 803.02 requires the Office to examine *all* claimed species when they “are sufficiently few in number . . . such that a search and examination of the entire claim can be made without serious burden.” In this case, the number of species in the various categories identified by the Office ranges two to four. The Office does not justify why searching any of the species are necessary, let alone whether the number of species across the five groups constitutes a burden.

Moreover, it is well established that each restriction and election requirements must be considered on its own merits. *See Id.* and M.P.E.P. § 1850. In the present case, rather than consider the merits of the case, the Office provides no justification relating to burden of search. All the compounds, cells, columns and tags from which Applicants were required to elect share a technical interrelationship with corresponding technical feature as defined by PCT 13.2 and which has not been destroyed. If the Office maintains the election, it is contravening PCT Rule 13.2 with this requirement. *See* M.P.E.P. 1850.

Therefore, Applicants respectfully request that the species election be reconsidered and withdrawn.

## **5.2 Species election is improper for dependent claims**

Applicants note further that the species are recited in dependent claims. M.P.E.P. § 806.04(f) states “to require restriction between claims limited to species, the claims must not overlap in scope.” At the very least, M.P.E.P. § 806.04(f) requires the Office to justify *why* claims issuing on the allegedly separate and distinct species would not overlap in scope. *See*

also M.P.E.P. § 806.05 ("Related inventions in the same statutory class are . . . not overlapping in scope, if a first invention would not infringe a second invention, and the second invention would not infringe the first invention."). The Office failed to justify the necessity of the election. Additionally, this could result in improper overlapping patents. Thus, the species election cannot be properly instituted as currently set forth.

Applicants respectfully request that the species election be reconsidered and withdrawn.

### CONCLUSION

Should the Office have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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